UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,635	02/15/2002	Masayuki Inai	KOT-0039	5481

7590 02/15/2006

CANTOR COLBURN LLP
55 Griffin Road South
Bloomfield, CT 06002

EXAMINER	
CANGIALOSI, SALVATORE A	
ART UNIT	**PAPER NUMBER**
3621	

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/077,635	INAI ET AL.	
	Examiner	Art Unit	
	Salvatore Cangialosi	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12/6/2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-4,6-20,27-29 and 34-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-4,6-20,27-29 and 34-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The following is a quotation of the first paragraph of 35 U.S.C. 112: The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-4, 6-20, 27-29, and 34-40 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The independent claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification as originally filed contains no support for "security level or a printer". There are new claims without support in the specification. This is the first instance of this invention that is unrelated and unsupported by the original filing. Cancellation of the new matter is required. The specification has support for copyright protection level but not security level.

2. The following is a quotation of 35 U.S.C. ∋ 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

3. Claims 2-4, 6-20, 27-29, and 34-40 are rejected under 35 U.S.C. ∋ 103 as being unpatentable over Onodera et al (6700677) or Holmes et al (6119108) in view of Auerbach et al (5673316) and either Shima (6369909 or 6940615).

Regarding claim 34, Onodera et al (See abstract, Figs. 1, 4 and 5, Col. 1, lines 40-65, claims 1-8) or Holmes et

al (See abstract, Figs. 1 and 2, Col. 2, lines 5-65, Col. 3, lines 10-50, claims 1-46) disclose printing system including a server which protects copyright and includes encryption control substantially as claimed. The differences between the above and the claimed invention is the use of specific portions for security level control, e.g. abstract. It is noted that it is believed that the copyright controls of the document are functionally equivalent to the claimed limitations. Auerbach et al (See Fig. 2, Col. 1, lines 50-65, Col. 5-40, claims 1-8) show encryption of document parts. Shima (See Figs. 14, 19, Col. 6, lines 50-65, and Col. 21, lines 5-20) show security level queries and control of network printers as being old and obvious (Note Epson assignee). It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Onodera et al or Holmes et al because the encryption control of Auerbach et al provides a much finer level of control of an electronic document because it caters to a multiplicity of users that may not need the entire document and therefore expands the market and provides greater levels of revenue to the copyright holder. Regarding the protection limitations of claim 2, Onodera et al(See abstract, Figs. 1, 4 and 5, Col. 1, lines 40-65, claims 1-8) or Holmes et al (See abstract, Figs. 1 and 2, Col. 2, lines 5-65, Col. 3, lines 10-50, claims 1-46) disclose printing system including a server which protects copyright and includes encryption control which is a functional equivalent of the claim

limitations. Regarding the encryption limitations of claim 3, Auerbach et al (See Fig. 2, Col. 1, lines 50-65, Col. 5-40, claims 1-8) show encryption of document parts which is a functional equivalent of the claim limitations. Regarding the output limitations of claim 4, Onodera et al (See abstract, Figs. 1, 4 and 5, Col. 1, lines 40-65, claims 1-8) or Holmes et al (See abstract, Figs. 1 and 2, Col. 2, lines 5-65, Col. 3, lines 10-50, claims 1-46) disclose printing system including a server which protects copyright and includes encryption control which is a functional equivalent of the claim limitations. Regarding the printing limitations of claims 6-8, Onodera et al (See abstract, Figs. 1, 4 and 5, Col. 1, lines 40-65, claims 1-8) or Holmes et al (See abstract, Figs. 1 and 2, Col. 2, lines 5-65, Col. 3, lines 10-50, claims 1-46) disclose printing system including a server which protects copyright and includes encryption control which is a functional equivalent of the claim limitations because the elements are conventional component of a standard printing system. Regarding the protection limitations of claims 9-20, Auerbach et al (See Fig. 2, Col. 1, lines 50-65, Col. 5-40, claims 1-8) show encryption of document parts which is a functional equivalent of the claim limitations. Regarding the protection limitations of claims 27-29, Auerbach et al (See Fig. 2, Col. 1, lines 50-65, Col. 5-40, claims 1-8) show encryption of document parts which is a functional equivalent of the claim limitations. Regarding the system limitations of claims 35-37,

Auerbach et al (See Fig. 2, Col. 1, lines 50-65, Col. 5-40, claims 1-8) show encryption of document parts which is a functional equivalent of the claim limitations. Regarding claim 38, Onodera et al (See abstract, Figs. 1, 4 and 5, Col. 1, lines 40-65, claims 1-8) or Holmes et al (See abstract, Figs. 1 and 2, Col. 2, lines 5-65, Col. 3, lines 10-50, claims 1-46) disclose printing system including a server which protects copyright and includes encryption control substantially as claimed. The differences between the above and the claimed invention is the use of specific portions for security level control, e.g. abstract. It is noted that it is believed that the copyright controls of the document are functionally equivalent to the claimed limitations. Auerbach et al (See Fig. 2, Col. 1, lines 50-65, Col. 5-40, claims 1-8) show encryption of document parts. Shima (See Figs. 14, 19, Col. 6, lines 50-65, and Col. 21, lines 5-20) show security level queries and control of network printers as being old and obvious (Note Epson assignee). It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Onodera et al or Holmes et al because the encryption control of Auerbach et al provides a much finer level of control of an electronic document because it caters to a multiplicity of users that may not need the entire document and therefore expands the market and provides greater levels of revenue to the copyright holder. Regarding claim 39, Onodera et al (See abstract, Figs. 1, 4 and 5, Col. 1, lines 40-

65, claims 1-8) or Holmes et al (See abstract, Figs. 1 and 2, Col. 2, lines 5-65, Col. 3, lines 10-50, claims 1-46) disclose printing system including a server which protects copyright and includes encryption control substantially as claimed. The differences between the above and the claimed invention is the use of specific portions for security level control, e.g. abstract. It is noted that it is believed that the copyright controls of the document are functionally equivalent to the claimed limitations. Auerbach et al (See Fig. 2, Col. 1, lines 50-65, Col. 5-40, claims 1-8) show encryption of document parts. Shima (See Figs. 14, 19, Col. 6, lines 50-65, and Col. 21, lines 5-20) show security level queries and control of network printers as being old and obvious (Note Epson assignee). It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Onodera et al or Holmes et al because the encryption control of Auerbach et al provides a much finer level of control of an electronic document because it caters to a multiplicity of users that may not need the entire document and therefore expands the market and provides greater levels of revenue to the copyright holder. Regarding claim 40, Onodera et al (See abstract, Figs. 1, 4 and 5, Col. 1, lines 40-65, claims 1-8) or Holmes et al (See abstract, Figs. 1 and 2, Col. 2, lines 5-65, Col. 3, lines 10-50, claims 1-46) disclose printing system including a server which protects copyright and includes encryption control substantially as claimed. The

differences between the above and the claimed invention is the use of specific portions for security level control, e.g. abstract. It is noted that it is believed that the copyright controls of the document are functionally equivalent to the claimed limitations. Auerbach et al (See Fig. 2, Col. 1, lines 50-65, Col. 5-40, claims 1-8) show encryption of document parts. Shima (See Figs. 14, 19, Col. 6, lines 50-65, and Col. 21, lines 5-20) show security level queries and control of network printers as being old and obvious (Note Epson assignee). It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Onodera et al or Holmes et al because the encryption control of Auerbach et al provides a much finer level of control of an electronic document because it caters to a multiplicity of users that may not need the entire document and therefore expands the market and provides greater levels of revenue to the copyright holder.

Examiner's Note: Although Examiner has cited particular columns, line numbers and figures in the references as applied to the claims above for the convenience of the applicant(s), the specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the individual claim and other passages and figures may apply as well. It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in

their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Applicants arguments dated 12/6/05 are moot due the new grounds of rejections, which were necessitated by the amendment filed 12/6/05.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Salvatore Cangialosi at telephone number **(571) 272-6927**. The examiner can normally be reached 6:30 Am to 5:00 PM, Tuesday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can

be reached at **(571) 272-6712**.

Any response to this action should be mailed to:

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to (703)872-9306

Hand delivered responses should be brought to

United States Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

SALVATORE CANGIALOSI
PRIMARY EXAMINER
ART UNIT 222